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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,419	07/29/2002	Roger J. Westcott	1832	5115

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EXAMINER

FONDA, KATHLEEN KAHLER

ART UNIT

PAPER NUMBER

1623

10

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,419

Applicant(s)

WESTCOTT ET AL.

Examiner

Kathleen Kahler Fonda, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,12-21,26-35,40-42,44-47,49-52,54,71,74,75 and 80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,12-21,26-35,40-42,44-47,49-52,54,71,74,75 and 80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: |

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Applicant's election without traverse of Group I, claims 1-8, 12-21, 26-35, 40-42, 44-47, 49-52, 54, 71, 74, 75, and 80, in Paper No. 9 is acknowledged.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 40-42, 44-47, and 49-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 40, 44, and 49 refer to "the method of Morrison & Laignelet (1983 Cereal Science 1, 9-20)" and thus fail to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant is reminded, in accordance with Ex parte Fressola (27 USPQ 2d 1608, BPAI 1993), that modern claim practice requires the claims to stand alone to define the invention. References to material outside the claims themselves are only permitted in very limited circumstances, which do not pertain to the instant situation. Thus the instant claims are indefinite.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 12-21, 26-35, 40-42, 44-47, 49-52, 54, 71, and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by AHAMED et al. (U). AHAMED teaches starch which reasonably appears to be within the scope of the claims; see pages 100-102 and Figure 5. Since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). Thus the claims are anticipated.

Claims 1-8, 12-21, 26-35, 40-42, 44-47, 49-52, 54, 71, 74, 75, and 80 are rejected under 35 U.S.C. 102(b) as being anticipated by WURZBERG et al. (AA). WURZBERG teaches starch

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which reasonably appears to be within the scope of the claims; see column 3 and Table I. Furthermore, WURZBERG states that the starch is appropriate for use as a thickener in products such as foods; see, for example, claim 14. Note the above discussion of In re Best and In re Fitzgerald. Thus the claims are anticipated.

Claims 1-8, 12-21, 26-35, 40-42, 44-47, 49-52, 54, 71, and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by YASUI *et al.* (V). YASUI teaches starch which reasonably appears to be within the scope of the claims; see page 133. Note the above discussion of In re Best and In re Fitzgerald. Thus the claims are anticipated.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 74, 75, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over AHAMED et al. (U).

Applicant claims a composition comprising a starch which exhibits freeze-thaw stability.

AHAMED teaches as set forth above. AHAMED does not explicitly disclose a composition as recited in claims 75 and 80. However, AHAMED does suggest use of the starch described therein in emulsion products. See the abstract.

It would have been obvious for a person of ordinary skill in the art at the time of the invention to include a starch of AHAMED in a composition as claimed. An ordinarily skilled worker would have been motivated to do so with a reasonable

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expectation of success because AHAMED had suggested its use in emulsion products.

Claims 1, 74, 75, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over YASUI *et al.* (V).

Applicant claims a composition comprising a starch which exhibits freeze-thaw stability.

YASUI teaches as set forth above. YASUI does not explicitly disclose a composition as recited in claims 75 and 80. However, YASUI does suggest use of the starch described therein in food products in the first full paragraph on page 132.

It would have been obvious for a person of ordinary skill in the art at the time of the invention to include a starch of YASUI in a composition as claimed. An ordinarily skilled worker would have been motivated to do so with a reasonable expectation of success because YASUI had suggested its use in food products.

No claim is allowed.

Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The number of the fax machine for official papers in Technology Center 1600 is

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(703) 308-4556. Any document submitted by facsimile transmission will be considered an official communication unless the cover sheet clearly indicates that it is an informal communication.

INTERNET INFORMATION: Secure and confidential access to patent application status information is now available; see <http://www.uspto.gov/ebc/index.html> for more information. Also, <http://www.uspto.gov/web/offices/ac/comp/fin/clonedefault.htm> may be used to pay patent maintenance fees, pay non-filing application fees, and maintain USPTO deposit accounts.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kathleen Kahler Fonda, at telephone number (703) 308-1620. Examiner Fonda can generally be reached Monday through Friday from 7:30 a.m. until 4:00 p.m. If the Examiner cannot be reached, questions may be addressed to Supervisory Patent Examiner James O. Wilson at (703) 308-4624. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-1235.



Kathleen Kahler Fonda, Ph.D., J.D.
Primary Examiner
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